

Application No.: 10/511,162
Inventor: Winterling et al.
Docket No.: 53429

REMARKS/ARGUMENTS

Claim Amendments

Applicant has amended claim 1 to recite, “heat conditioning a mixture comprising titanium dioxide to produce a titanium dioxide catalyst having a BET surface area in the range from 5 to 30 m²/g determined according to the German standard DIN 66 131 volumetrically by the multipoint method,” and that, “the conditioned titanium dioxide catalyst has an equivalent catalytic activity when compared with the unconditioned titanium dioxide under identical process parameters.” Support for the claim amendment can be found at least at page 13, line 43 – page 14, line 2 and page 15, lines 1 – 36 of the original specification.

Applicant has presented new claims 10 – 14, support for which can be found at least at page 11, lines 1 – 31 and page 15.

No prohibited new matter has been entered.

Entry and consideration of the instant claim amendments after final is respectfully requested as the instant claim amendments place the application in condition for allowance and/or in better format for Appeal and/or further limit issues which may be raised on appeal.

Applicants respectfully submit that the instant amendments were not previously submitted as the issues addressed by the amendments were only raised by the Examiner for the first time in the Final action, *i.e.*, alleged agglomeration of catalyst particles as a result of heat conditioning, which results in changes to catalyst particle size. Accordingly, Applicants could not have made the requisite claim amendments obviating the issues at an earlier stage in the proceedings. Additionally, the instant claim amendments merely obviate the issues newly raised by the Examiner and do not change the scope of the claims or add new matter which would necessitate further substantial examination and/or search by the Examiner.

Claim Rejections under 35 USC § 103

Claims 1-9 stand rejected under 35 USC § 103 as allegedly obvious in view of the disclosures of Mohrschaldt (US 6,316,588) and Mohrschaldt (US 6,288,207). Applicant has amended claim 1 to recite the step of heat conditioning the titanium dioxide catalyst as well as to

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clarify that the heat conditioned catalyst has an equivalent activity when compared with an unconditioned catalyst under identical process parameters, which features are not described, taught or necessarily predictable from the disclosures of Mohrschaldt (US 6,316,588) and Mohrschaldt (US 6,288,207).

Along the above lines, the Examiner is kindly directed to page 13, line 37 – page 14, line 2 which states, “[c]ompared with the processes of WO 99/38906 [which is equivalent to US 6,288,207], WO 99/38908 [which is equivalent to US 6,316,588] and WO 01/09224, the process of the invention gives a polyamide with reduced titanium dioxide content while other process parameters, such as pressure, temperature, material flow rates, concentrations, and starting materials remain the same. Surprisingly, it has been found here that the reduction in catalyst activity claimed in the prior art for the BET surface area of the catalyst of the present invention does not occur, the catalyst activity in the process of the invention in fact being just as high as in the processes described in WO 99/38906 [which is equivalent to US 6,288,207], WO 99/38908 [which is equivalent to US 6,316,588] and WO 01/09224.” (Emphasis added). Additionally, Applicant’s experimental data sets forth that identical process parameters were used for both plain titanium dioxide pellets as well as heat conditioned titanium dioxide pellets such that the disclosures of Mohrschaldt (US 6,316,588) and Mohrschaldt (US 6,288,207) teach away from the instant claims. As noted by the Examiner in the Non-final action of August 31, 2006, “both references expressly teach that catalysts with a lower BET may be used, but in that case the volume of the catalyst bed should be increased to maintain the appropriate catalytic activity.” (emphasis added).

Accordingly, it is seen that, given identical process parameters, the claimed process produces results that are unexpected, proceeds contrary to conventional wisdom and/or would not have been predictable from the disclosures of Mohrschaldt (US 6,316,588) and Mohrschaldt (US 6,288,207).

Consequently, because the combination of Mohrschaldt (US 6,316,588) and Mohrschaldt (US 6,288,207) fail to describe each and every element of the claims as amended, and because the instant claimed invention produces results that are unexpected and in complete contrast to the disclosures of Mohrschaldt (US 6,316,588) and Mohrschaldt (US 6,288,207) and that knowledge

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available to the ordinarily skilled artisan, the instant claims are not obvious.

In view of the above, the rejection should be withdrawn.

Conclusion

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested. Applicant respectfully petitions for a one-month extension of time. The respective fee of \$120.00 is paid by credit card. Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 14-1437. Please credit any excess fees to such deposit account.

Respectfully submitted,

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Attachments

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